

REMARKS

Election / Restrictions

The Applicants hereby confirm election of Group I, claims 1-7. Claims 8-12 have been cancelled without prejudice and expressly reserving the right to present them in future related applications.

Amendment of the specification

The language of the paragraph beginning at page 5, line 4 of the specification has been amended to describe base 49 and support arm 48 and the functions thereof. The Applicants submit that support for these amendments is unambiguously found in FIG. 2. No new matter has been added.

Amendment of the claims

The language of claim 1 has been amended to recite "a base, positioning the precise cutting device", to recite that the support arm extends "upward from the base" and to recite that the cutter is disposed "on the base" and that "said cutter is fixed horizontally selective to said base". The Applicants submit that support for these amendments can be found, for example, in FIG. 2 and/or in the portion of the specification corresponding to FIG.2.

Minor language amendments have been conducted in claim 6. The dependency of claim 7 has been changed from claim 1 to claim 6. New claim 13 has been added and recites a light source. Support for these amendments can be found, for example, in FIG. 2 and in the corresponding portion of the specification.

No new matter has been added.

Rejection under 35 U.S.C 112

Claim 7 stands rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner finds that "the image sensor" lacks antecedent basis. The Applicants submit that claim 7 has been amended to depend on

claim 6. Claim 6 recites "an image sensor" and provides support for "the image sensor" of claim 7. The Applicants therefore respectfully ask that the Examiner withdraw this rejection of claim 7.

Rejection under 35 U.S.C 102

Claims 1-4 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,174,188 to Petroz. The Applicants respectfully disagree.

Rejection of claim 1

Petroz discloses, at column 7, lines 16-20, a cutter/point 40 that is "*mounted on a first platen 42 which provides for the motion of point 40 in translation along axes X and Y*", wherein "*platen 42 is itself mounted on another platen 44 which can be moved in translation in a direction parallel to axis Z*." The Applicants submit that Petroz teaches disposing cutter 40 on a complex X.Y.Z mobile stage 42; 44, and thus teaches away from disposing a cutter on a base so that it is not mobile horizontally, and in particular "*a cutter disposed on the base under the stage of the microscope... wherein said cutter is fixed horizontally selective to said base*" as recited in claim 1. The Applicants therefore submit that claim 1 is patentable over Petroz.

Rejection of claims 2-4

Claims 2-4 depend on claim 1. The applicants submit that claims 2-4 are patentable over Petroz at least in view of their dependency on claim 1.

Rejection under 35 U.S.C 103

Claim 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Petroz in view of U.S. Pat. No. 3,812,748 to Habeck or in view of U.S. Pat. No. 3,812,748 to Nausbaum and claims 6, 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Petroz in view of published U.S. Patent application No. 2002/056345 to Genser or in view of U.S. Pat. No. 5,974,903 to Shirley. The Applicants respectfully disagree.

Rejection of claim 5

Claim 5 depends on claim 1. The Applicants submit that the Examiner fails to show that either Habeck or Nausbaum disclose or suggest "*a cutter disposed on the base under the stage of the microscope... wherein said cutter is fixed horizontally selective to said base*" as recited in claim 1. In view of the above, the Applicants submit that no combination of Petroz and either Habeck or Nausbaum would have led to a cutting device as recited in claim 1. The Applicants therefore submit that claim 1 is patentable over Petroz in view of Habeck or Nausbaum, and that, at least in view of its dependency, claim 5 is patentable over Petroz in view of Habeck or Nausbaum.

Rejection of claims 6, 7

Claim 6 depends on claim 1 and amended claim 7 depends on claim 6. The Applicants submit that the Examiner fails to show that either Genser or Shirley disclose or suggest "*a cutter disposed on the base under the stage of the microscope... wherein said cutter is fixed horizontally selective to said base*" as recited in claim 1. In view of the above, the Applicants submit that no combination of Petroz and either Genser or Shirley would have led to a cutting device as recited in claim 1. The Applicants therefore submit that claim 1 is patentable over Petroz in view of Genser or Shirley, and that, at least in view of their dependency, claims 6, 7 are patentable over Petroz in view of Genser or Shirley.

New claim 13

New claim 13 depends on claim 1. In view of the above, the Applicants submit that, at least because of its dependency on claim 1, claim 13 is patentable over the cited documents.

Prior art made of record and not relied upon

Regarding the prior art made of record by the Examiner but not relied upon, Applicants submit that the Examiner has failed to show that any of the prior art documents made of record disclose or suggest "*a cutter disposed on the base under the stage of the microscope... wherein said cutter is fixed horizontally selective to said base*" as

recited in claim 1, and therefore submit that claim 1, as well as dependent claims 2-7 and 13 are patentable over said prior art documents.

* * *

In view of the above, Applicants submit that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue.

The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

February 7, 2005

(Date of Transmission)

Corinda Humphrey
(Name of Person Transmitting)

Corinda Humphrey
(Signature)

February 7, 2005

(Date)

Respectfully submitted,



Robert Popa
Attorney for Applicants
Reg. No. 43,010
LADAS & PARRY
5670 Wilshire Boulevard, Suite 2100
Los Angeles, California 90036
(323) 934-2300 voice
(323) 934-0202 facsimile
rpopa@ladasperry.com